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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,136	01/16/2001	Terry Tam	8673-112 (8061-567 SJP/KI)	3423
22150	7590	08/12/2005	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			GEREZGIHER, YEMANE M	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/761,136	TAM, TERRY	
	Examiner	Art Unit	
	Yemane M. Gerezgiher	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

YMG

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DETAILED ACTION

Response to Amendment

1. Amendment filed on 05/31/2005 has been entered. Claims 1-16, and newly added claims 18-20 are now pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 18, recites "an **apparatus configured to encode and transmit** a PDU according to claim 1". The inventive entity failed to point where such supports exist in the specification. Examiner notes that the specification is substantially describing a method of encoding a PDU (Protocol Data Unit) using a protocol named "SSSP" (Simple Supplementary Service Protocol). **There is no indication of a hardware setup configured to perform the invention as claimed.**

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, the inventive entity recites, a **method claim followed by a data structure having therein data fields**, which is **improper hybrid claim**. A method claim should comprise functional steps and not just data fields, which are non-functional descriptive material.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-16 and 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1: A Protocol Data Unit encoded in accordance with a Simple Supplementary Services Protocol (SSSP) for encoding Protocol Data Units (PDUs) which are and carried via messages over an existing protocol for network communications, comprising:

an identifier field for identifying different functionally based

supplementary services;

an end tag field for denoting message endings; and

a parameters extensions field separating said identifier field and said end tag field.

a. The claim is directed to a non-statutory subject matter, which is merely a PDU encoded with a protocol recited as "SSSP", which is not it is not tangibly embodied in a manner so as to be executable.

Furthermore, a PDU comprising **a collection of fields** including *an identifier field separating different functionally based supplementary services; an end tag field denoting message endings; and a parameters extensions field separating said identifier field and said end tag field*, is merely **a data structure**, which is minimally an **abstract** idea.

b. Further, the recited limitations are directed to a non-statutory subject matter because the limitations are directed to a non-functional descriptive material, which lack practical application.

c. The PDU comprising identifier fields identifying supplementary services ... and further detailing and limiting depending claims 2-16 fall under the same category. According to the patent law, claimed invention, as a whole must produce a "useful, concrete and tangible" result to have a practical application resulting in a useful, concrete, and tangible result where usefulness under patent eligibility requires considerable functionality present to complete useful outcome aspect of the practical

application. See MPEP 2106 (Patentable Subject Matter - Computer-Related Inventions). The presented claims in this application failed to satisfy the requirement described above. Moreover the patent law requires that one may patent something that is **a machine, manufacture, composition of matter or a process**. However, a PDU encoded using "SSSP" does not fall in any categories of process, machine, manufacture or composition of matter so to be given a patentability weight. Thus, Claims 1-16 remains rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter for almost failing on all possible requirements of the 35 U.S.C. 101 rejections.

d. Claims 18 and 19, has substantially the same limitations as in claim 1, therefore it is rejected with the same rationale. Even though claim 18 calls for an apparatus and claim 19 calls for a method, the claims are both directed to a non-statutory subject matter, because *an identifier field separating different functionally based supplementary services; an end tag field denoting message endings; and a parameters extensions field separating said identifier field and said end tag field*, is merely **a data structure**, which is minimally an **abstract** idea, which is a non-functional descriptive material.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-16, 18, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korpi et al. (U.S. Patent Number 6,621,814) in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

Korpi disclosed a method and apparatus for transmitting voice data in data packets with additional supplementary services (See Title). Korpi addressed the drawback of the standards that are approved very little by little by the ITU for additional supplementary services taking a long time before such standards are defined (See Column 2, Lines 30-44). Korpi disclosed a method off encoding additional supplementary services in a fashion compatible with the existing protocol of transmitting the existing standard supplementary services. See Column 3, Lines 27-62. Korpi taught that the ITU-T Standard H.323 allowing an expansion by new signaling protocol utilizing additional supplementary services where the protocol used is the existing H.323 protocol.

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See Column 5, Lines 40-49 and Column 1, Line 22 through Column 12, Line 16. Korpiu substantially disclosed the invention as claimed. However, Korpi was silent about the specifics of the PDUs encoding including identifier fields identifying functionally different supplementary service, the use of alphanumeric string encoding, the use of a comma and/or an asterisk as a ParameterSeperator, a protocol tag, the limited size of the characters used to describe multiple data fields.

PDU is commonly defined as *“a message of a given protocol comprising payload and protocol-specific control information, typically contained in a header. PDUs pass over the protocol interfaces which exist between the layers of protocols (per OSI model).”* Korpiu taught a method and apparatus of providing additional supplementary services that are compatible with the existing H.450.x standards. Since the teachings of Korpiu disclosed a method of providing additional supplementary services, the use of plurality of parameters was inherently disclosed. Further, since the disclosed teaching deals with the pluralities of parameters or the data/identifier fields the use of some parameter separator was inherent. Accordingly, the use of a “comma”, “asterisk” as a parameter separator, limiting the size of the string or character to one or more in order to describe the message type and generally to define different sets of fields in encoding a PDU is an arbitrary preference which does not change the end-result of the invention as claimed.

An artisan working with the invention of Korpiu related to additional supplementary services that are compatible with the existing protocol would have realized that the implementation (reduction to practice) step would require an arbitrarily syntax selection, alphanumeric encoding, and selection of arbitrary characters to separate parameters or to indicate a message type and describe fields of data in the PDU. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention to make arbitrary choices of alphanumeric encoding and selection of arbitrary characters and have modified the teachings of Korpiu related providing additional supplementary services in the H.323 systems in order to distinguish the added supplementary services from the existing standard H.450.x.

Response to Arguments

5. Applicant's arguments filed 05/31/2005 have been fully considered but they are not persuasive.

6. The inventive entity recites “a protocol data unit encoded in accordance with a simple supplementary services protocol and carried via messages over an existing protocol for network communications, without the requirement of any “interface unit” or a “conversion unit” as required by Korpi” (**Applicant’s Remark on Page 8 2nd ¶**).

Examiner respectfully disagrees with such statement, because there exist no method claim with functional limitations or steps showing the novelty (if any) that clearly distinguish from the teachings of the prior art (Korpi) as applied.

Nowhere in the body of the claims does it say encoding of PDU's "without the requirement of any "interface unit" or a "conversion unit"". Nevertheless, there are no functional steps and/or limitations claimed apart from the already rejected claims (claims directed to non-statutory subject matter as rejected above).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yemane M. Gerezgiher whose telephone number is (571) 272-3927. The examiner can normally be reached on 9:00 AM - 6:00 PM Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached at (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMG

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